

REMARKS

In the Office Action dated August 28, 2009, in which claims 1-15 and 42 were pending, the Examiner acknowledged that Technology Center 3700 Director Donald T. Hajec approved the reopening of prosecution of the present invention following a Board of Patent Appeals and Interferences ("BPAI") decision, and asserted the following grounds of rejection:

claims 1-7, 10-15 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over published U.S. Patent Application No. 2002/0022762 to Beane et al. ("Beane");

claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of U.S. Patent No. 5,720,391 to Dohm et al. ("Dohm"); and

claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beane in view of U.S. Patent No. 6,910,582 to Lantz ("Lantz").

Applicant herein adds new claim 43. Claims 1-15 and 42 are presented, without amendment, for reconsideration and claim 43 is newly presented for consideration, in view of the following comments.

Prior to addressing the rejections in relation to the language of the claims, Applicant respectfully submits that the Examiner's rejections are without merit as a matter of law, and should be withdrawn. In the previous Office Action, the Examiner rejected claims 1-7, 10-15 and 42 under 35 U.S.C. § 102(b) as being anticipated by Beane; claim 8 under 35 U.S.C. § 103(a) as being obvious over Beane in view of Dohm; and claim 9 under 35 U.S.C. § 103(a) as being obvious over Beane in view of Lantz. Applicant responded to the Examiner's rejections. The Examiner was not persuaded. Accordingly, Applicant appealed the rejections to the BPAI.

In the BPAI decision dated July 22, 2009, the BPAI reversed the Examiner's rejections, some of which were presented again in the present Office Action. In particular, the BPAI stated that the Examiner failed to provide sufficient evidence in the prior art of "*a self-sealing mechanism disposed within the canal*", as recited in claim 1 (BPAI Decision, p. 7, ll. 8-10 & 23-25). The decision of the BPAI, namely, that Beane, Dohm and Latz, either alone or in combination, do not render obvious the recitations of claim 1, is binding on the Examiner under the doctrine of *res judicata* (see, e.g., MPEP § 706.03(w)). Thus, Applicant respectfully submits that the rejections asserted by the Examiner in the present Office Action are improper as a matter of law, and should be withdrawn.

Further, after the BPAI has reversed an Examiner's decision, "prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown" (MPEP § 1214.07 *citing* 37 CFR 1.198) (emphasis added). However, the Examiner's presently asserted rejections have already been adjudicated. Specifically, the BPAI held that the Examiner had failed to provide sufficient evidence from the prior art to substantiate an anticipation or obviousness rejection. On appeal before the BPAI, the Examiner had produced the Beane, Dohm and Latz references. In the present Office Action, the Examiner has not produced any additional evidence in support of the rejections, but, instead, continues to rely upon Beane, Dohm and Latz. In fact, the Examiner's allegedly new rejection merely converts the rejection of claims 1-7, 10-15 and 42 from one of anticipation under Section 102(b) to one of obviousness under Section 103(a), both in view of Beane. Applicant respectfully submits that the Examiner has once again failed to provide sufficient evidence from the prior art to support the asserted rejections. Thus, under MPEP § 1214.07, the Examiner

has failed to present matters that were not already adjudicated and the present Office Action, which reopened prosecution of the present application, should not have been issued.

In addition, the BPAI's decision held that the recitations of claims 8 and 9, which incorporate each and every recitation of claim 1 from which they depend, are not obvious in view of Beane in view of Dohm and Lantz, respectively. Therefore, claim 1 cannot possibly be obvious in view of Beane, alone, as the Examiner asserts in the present Office Action.

The BPAI's decision also expressly addressed and reversed the rejections of claims 8 and 9 as being obvious over Beane in view of Dohm and Lantz, respectively. In particular, the BPAI stated "We do not find that Dohm or Lantz overcome the deficiencies of Beane, and the rejections of claims 8 and 9 are reversed" (BPAI Decision, p. 7, ll. 10-20). Thus, the Examiner's rejection of claims 8 and 9 as being obvious over Beane in view of Dohm and Lantz, respectively, is improper as a matter of law, and should be withdrawn.

In summary, the Examiner has previously made substantially the same rejections as are presently asserted against claims 1-15 and 42. Applicant successfully traversed the Examiner's rejections through argumentation. On appeal, the BPAI, in finding for Applicant, stated that the Examiner's rejections were improper. The decision of the BPAI is binding upon the Examiner. The Examiner can reopen prosecution following an appeal by satisfying the requirements of MPEP § 1214.07. The Examiner has failed to satisfy the requirements of § 1214.07 by only presenting matters that have already been adjudicated. Thus, prosecution should not have been re-opened and the present application should have, instead, been passed to issue.

Therefore, Applicant respectfully submits that the Examiner's rejections are improper as a matter of law for at least the above-identified reasons, and should be withdrawn.

Claims 1-7, 10-15, 41 and 42 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Beane. The rejection is traversed and reconsideration is respectfully requested.

Beane is directed to a lens warming and cleaning device for use with an optical surgical instrument. The device includes a heat-conducting tube sized and shaped to receive the lens portion of the instrument, a heating element thermally coupled to an exterior of the tube, and a cleaning member disposed within the tube. The cleaning member is disposed such that when the lens portion of the instrument is inserted into the tube, the lens portion contacts the cleaning member.

Beane does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal, as is generally recited in independent claim 1 and incorporated in dependent claims 2-7, 10-15 and 42. This is not surprising since Beane is limited to a saline solution retained in a sponge.

For a *prima facie* case of obviousness to be appropriate, each and every element or limitation in a rejected claim must be taught or suggest the prior art reference(s) used in the claim rejection. Because Beane does not teach or suggest a sterile apparatus to protect endoscopes wherein the apparatus includes a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact

defogging material and to prevent the defogging material from spilling out of the canal, as is generally recited in independent claim 1, it cannot be maintained that Beane renders obvious claim 1. Moreover, because claims 2-7, 10-15 and 42 each ultimately depend from and thereby incorporate the limitations of claim 1, these dependent claims are not rendered obvious by Beane for at least the reasons set forth for claim 1.

Accordingly, Applicant respectfully submits that the rejection of claims 1-7, 10-15 and 42 under 35 U.S.C. § 103(a) as being obvious over Beane is improper for at least these reasons, and should be withdrawn.

Claim 8 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beane in view of Dohm. The rejection is traversed and reconsideration is respectfully requested.

Dohm is directed to packaging and a holder provided for a heart valve prosthesis. The holder is adapted to grasp the heart valve prosthesis and includes a post. The packaging includes a collar for holding the post of the holder. An inner tray of the packaging receives the collar such that the prosthesis is suspended within the inner tray. An outer tray receives the inner tray. An inner tray lid seals the inner tray and an outer tray lid seals the outer tray.

The Examiner apparently cites Dohm for mentioning that Styrofoam can be used for a transportation case for medical instruments. However, claim 8 ultimately depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Beane contains insufficient teaching to render obvious claim 1. It therefore follows that Beane also contains insufficient teaching when taken either alone or in combination with Dohm to render claim 8 obvious.

Accordingly, Applicant respectfully submits that the rejection of claim 8 under 35 U.S.C. § 103(a) as being obvious over Beane in view of Dohm is improper for at least these reasons, and should be withdrawn.

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beane in view of Lantz. The rejection is traversed and reconsideration is respectfully requested.

Lantz is directed to a shock absorbing insulated shipping container including an external corrugated cardboard box, receiving an insulated body having a cavity for holding breakable glass bottles. The bottles may contain a high value liquid product being shipped, such as medicine or wine. The container also receives an especially configured and constructed, shock-absorbing filling structure or partition system for separating the glass bottles from one another, and from one or more receptacle cavities for holding phase change coolant or temperature control material in a predetermined relationship to the glass bottles. The container also includes an insulating and cushioning cover adapted to engage into a top opening of the insulated body after the bottles and coolant are received in the cavity thereof. The insulated body is formed from injection molded polyurethane, wrapped in a plastic film.

The Examiner apparently cites Lantz for mentioning that gel can be used for a transportation case for cushioning. However, claim 9 ultimately depends from and thereby incorporates the limitations of claim 1. It has been demonstrated above that Beane contains insufficient teaching to render obvious claim 1. It therefore follows that Beane also contains insufficient teaching when taken either alone or in combination with Lantz to render claim 9 obvious.

Accordingly, Applicant respectfully submits that the rejection of claim 9 under 35 U.S.C. § 103(a) as being obvious over Beane in view of Lantz is improper for at least these reasons, and should be withdrawn.

New claim 43 recites, *inter alia*, a self-sealing mechanism disposed within a canal and configured to allow for an endoscope to enter the canal and contact defogging material and to prevent the defogging material from spilling out of the canal. Therefore, for at least the reasons set forth above, Applicant believes that new claim 43 is not obvious in view of the cited prior art references – Beane, Dohm and Lantz.

In addition, claim 43 recites a number of other features that Applicant does not believe are taught or suggested in the prior art.

Applicant respectfully acknowledges the Examiner's continued use of the Beane, Dohm and Lantz references as an expression that these are the most-relevant references with respect to the present invention. However, the BPAI, which has binding authority over the Examiner, explicitly found that these references fail to anticipate or render obvious claims 1-15 and 42-43 of the present invention. Therefore, Applicant respectfully submits that claims 1-15 and 42-43 must be patentable over the prior art.

In view of the foregoing, it is respectfully submitted that claims 1-15 and 42-43 are in condition for allowance. All issues raised by the Examiner having been addressed – both in this Response and in the BPAI's decision dated July 22, 2009, an early action to that effect is earnestly solicited.

Applicant respectfully submits that nothing in this Amendment and Response constitutes new matter. Support for the amendments can be found in, at least, paragraphs [0012]-[0013], [0015]-[0017], [0021], [0023], [0025]-[0026] and [0032] and Figure 6.

Applicant does not believe that any fees are due in connection with this Amendment and Response. However, authorization is hereby given to charge our Deposit Account No. 13-0235 in the event any such fees are owed.

Respectfully submitted,

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